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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,199	04/13/2004	Akio Saiki	1004378.51670 (5000-5167)	4036
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EXAMINER				
PARVINI, PEGAH				
ART UNIT		PAPER NUMBER		
1731				
NOTIFICATION DATE		DELIVERY MODE		
01/18/2011		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ptopatentcommunication@lockelord.com

Office Action Summary

Application No.

10/823,199

Applicant(s)

SAIKI ET AL.

Examiner

PEGAH PARVINI

Art Unit

1731

Period for Reply
-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3, 4, 7, 15-19, 21, 23 and 24 is/are pending in the application.
- 4a) Of the above claim(s) 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 4, 7, 15-19, and 23-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 April 2004 and 01 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of Hearings Filed (PTO-502)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicants' submission filed on 11/8/2010 has been entered.

Response to Amendment

This Office Action is in reply to the amendment filed 11/8/2010. After entry of this reply, claims 1, 3-4, 7, 15-19, 21, and 23-24 are currently pending in this application with claim 21 being withdrawn from further consideration.

Priority

Acknowledgment is made of applicants' claim for foreign priority based on an application filed in Japan on 04/14/2003. It is noted, however, that applicant has not filed a certified copy of the 2003-109597 application as required by 35 U.S.C. 119(b).

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 24 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not provide support for the claimed coating composition comprising no polyamide. If a specific compound should not be present in an invention, there should be clear indication to that in the claims as originally filed or the specification.

It should be noted that according to MPEP 2173.015(j):

Any negative limitation or exclusionary proviso must have basis in the original disclosure. If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) ("[the] specification, having described the whole, necessarily described the part remaining."). See also *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff'd mem.*, 738 F.2d 453 (Fed. Cir. 1984). The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Note that a lack of literal basis in the specification for a negative limitation may not be sufficient to establish a *prima facie* case for lack of descriptive support. *Ex parte Parks*, 30 USPQ2d 1234, 1236 (Bd. Pat. App. & Inter. 1993). See MPEP § 2163 - § 2163.07(b) for a discussion of the written description requirement of 35 U.S.C. 112, first paragraph.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-4, 7, 15-19 and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 4,742,110 to Sakashita et al.

Regarding claims 1, 3-4, 7, and 15-19, Sakashita et al. disclose a polyamide moldable composition which has improved mechanical and thermal characteristics wherein said composition comprises polyamide-imide, a mixture of one or more fillers such as titanium oxide powder and polytetrafluoroethylene (i.e. PTFE) each in an amount of, preferably 0.5 to 50 parts by weight per 100 parts by weight of the polyamide and silane coupling agent which is used to treat the fillers (Abstract, column 1, line 60 to column 2, line 5; column 5, line 62 to column 6, line 47). Furthermore, Sakashita et al. teach an average particle size of 0.1 μ m to 200 μ m for the filler particles (i.e. titanium oxide particles) (column 6, lines 36-41).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have selected a particle size within the disclosed range of 0.1 μ m to 200 μ m since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 220 F.2d 454, 105 USPQ 223 (CCPA 1955).

Although the reference may not expressly and literally disclose the amount of silane used, it would have been obvious to a person of ordinary skill in the art at the

time the invention was made to have utilized an amount of silane which would have, at least, overlapping ranges with the ones instantly claimed since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

It is noted that the Sakashita et al. disclose overlapping ranges with reference to the amounts of the titanium oxide powder and PTFE compared with the ones instantly claimed, and overlapping ranges have been held to establish *prima facie* obviousness. MPEP § 2144.05.

With reference to the preamble reciting "A wear resistance and seizure resistance film formed on a sliding part", it is noted that this is an intended use for the coating composition which follows this segment of the claim language. With reference to the statement of intended use, MPEP § 2111.02 states:

During examination, statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the recited purpose or intended use results in a structural difference (or, in the case of process claims, manipulative difference) between the claimed invention and the prior art. If so, the recitation serves to limit the claim. See, e.g., *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963).

With reference to a film forming from said composition, it is noted that Sakashita et al. is drawn to a moldable composition with improved mechanical and thermal characteristics and to a composition which is excellent in molding characteristics. Therefore, it is the position of the examiner that the composition of Sakashita et al. may be molded in any form and shape such as into a film absence clear evidence showing the contrary.

With reference to the recitation drawn to the sliding parts and that the sliding parts are metal, it is noted that claim 1 is drawn to a composition forming film; thus, a recitation drawn to sliding parts or metal sliding parts as claimed instantly do not impart any distinction on the composition of claim 1 as they do not further limit the composition but are drawn to the intended use of the claimed composition.

With reference to the limitation of "by applying the coating composition to the sliding part and curing the applied coating composition", it is to be noted that this is a process limitation in a product claim. The limitations directed to the method of using the claimed composition are not considered to add patentable weight to the examination of the product claims as they do not further limit the composition.

With further reference to claim 23, it is to be noted MPEP 2111.02, as also pointed out by Applicants, states:

The transitional phrase "consisting essentially of" limits the scope of a claim to the specified materials or steps "and those that do not materially affect the basic and novel characteristic(s)" of the claimed invention. *In re Herz*, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976).....For the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising.".....If an applicant contends that additional steps or materials in the prior art are excluded by the recitation of "consisting essentially of," applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant's invention. *In re De Lajarte*, 337 F.2d 870, 143 USPQ 256 (CCPA 1964). See also *Ex parte Hoffman*, 12 USPQ2d 1061, 1063-64 (Bd. Pat. App. & Inter. 1989).

With further reference to claim 24, regarding the negative limitation of "wherein the coating composition comprises no polyamide", it is to be noted that MPEP 2173.05(i) states:

Any negative limitation or exclusionary proviso must have basis in the original disclosure. If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) ("[the] specification, having described the whole, necessarily described the part remaining."). See also *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff'd mem.*, 738 F.2d 453 (Fed. Cir. 1984). The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Note that a lack of literal basis in the specification for a negative limitation may not be sufficient to establish a *prima facie* case for lack of descriptive support. *Ex parte Parks*, 30 USPQ2d 1234, 1236 (Bd. Pat. App. & Inter. 1993). See MPEP § 2163 - § 2163.07(b) for a discussion of the written description requirement of 35 U.S.C. 112, first paragraph.

Response to Arguments

Applicants' arguments filed November 8, 2010, have been fully considered but they are not persuasive.

Applicants have argued that C8 of Table 1 is an example of the claimed composition containing only the four components recited in instant claims. Then, they further argue that therefore C8 provides support for new claim 24 where said claim recites "the coating composition comprises no polyamide in new claim 24".

The examiner, respectfully, submits that just because C8, on example, discloses certain components, it does not mean that whatever else which is not disclosed in said example or any other examples should not and cannot be present. If a specific compound should not be present in an invention, there should be clear indication to that in the claims as originally filed or the specification.

Applicants, in page 8, have argued that Sakashita fails to teach or disclose a coating composition *consisting of* a polyamide or polyamide-imide binder resin.

The examiner, respectfully, submits neither claim 1 nor any other claim utilizes the transitional phrase "consisting of" which, as defined in MPEP, limits the scope of a claim to the specific components or steps recited.

Applicants have argued that the imide-based resin of Sakashita does not function as a binder resin.

The examiner, respectfully, submits that while the reference discloses the same compound (i.e. polyamide-imide) which is claimed instantly, it is taken to impart the effect of a binder resin even though this may not have been literally disclosed in instant reference because it is not clear as how applicants attempt to argue that polyamide-imide does not have the effect of a binder resin while applicants claim that it does in their own claims. If this compound can be a binder resin, as applicants argue that it can, then, the polyamide-imide can be a binder resin.

Furthermore, instant claims, except claim 23 which is addressed in this action, recite the language of "comprising" which is an open language; thus, considering the fact that the reference teaches the components of the recited claims or make obvious (see previous Office Action) clearly reads on the recitation of the instant claims. In addition, no sufficient support is found claims as originally filed or in the specification to indicate the exclusion of using polyamide.

With reference to applicants' argument drawn to the recitation of "the film is adapted to be formed on a sliding part by applying the coating composition to the sliding part and curing the applied coating composition", it should be noted that this is drawn to the usage and process of using the claimed composition. While the claimed composition is taught in the reference as detailed out above, the reference is seen to teach on the limitation of instant claims absence evidence proving the contrary since the way the composition is used or process of using it does not further limit the composition itself. Applicants need to show by way of tangible evidence that the claimed invention results in a structural difference between the claimed invention and the prior art.

With reference to applicants' remarks drawn to "consisting essentially of", it is to be noted that MPEP 2111.02 states:

The transitional phrase "consisting essentially of" limits the scope of a claim to the specified materials or steps "and those that do not materially affect the basic and novel characteristic(s)" of the claimed invention. *In re Herz*, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976).....For the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising.".....If an applicant contends that additional steps or materials in the prior art are excluded by the recitation of "consisting essentially of," applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant's invention. *In re De Lajarte*, 337 F.2d 870, 143 USPQ 256 (CCPA 1964). See also *Ex parte Hoffman*, 12 USPQ2d 1061, 1063-64 (Bd. Pat. App. & Inter. 1989).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PEGAH PARVINI whose telephone number is (571)272-2639. The examiner can normally be reached on Monday to Friday 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Pegah Parvini/
Examiner, Art Unit 1793

/Anthony J Green/
Primary Examiner, Art Unit 1731